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THE H. T. THAN LAW GROUP
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WASHINGTON, DC 20007

EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/879,734

Applicant(s)

BURGES ET AL.

Examiner

Matthew B. Smithers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-13,17,18,20,21 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-13,17,18,20,21,27 and 29 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed August 1, 2007 have been fully considered but they are not persuasive. Applicant argues the system of Wells (20040024714) does not teach or suggest the owner of an electronic safety deposit box manages the further users access to the data storage space with regard to times and dates where the at least one further user can write to and/or read from the data storage. The examiner respectfully disagrees and asserts Wells does suggest in paragraph [0037] that the owner can manage a further users access to the electronic deposit box. Wells teaches the owner has access to "Box Management Tools" which allow the user to control access to the data storage space. Through the "Box Management Tools" an owner is able to delete or modify the license associated with the box. The license is set with an expiration date and it allows a third party user the ability to access the storage space during times and dates prior to its expiration. Further, Wells teaches in paragraph [0028] the user (owner) prevents the further users from modifying (writing) the documents without the users authorization. This suggests the user (owner) controls a further users permission to modify (write) the owner's document. Also, Wells teaches the user designates a set of access privileges for the third party where one of the access privileges is a read privilege (see claims 1-3 of Wells). As presently written, applicant's claims 1 and 9 are not limited to having both a write and read access privilege. Applicant's claims 1 and 9 provide the option of a write access, a read access and the

combination of the two accesses. Therefore, the examiner submits Wells does meet the claimed invention and the previous rejection of Wells is maintained below.

Claim Objections

Applicant is advised that should claim 13 be found allowable, claim 29 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-11, 13, 20, 21, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 20040024717 granted to Wells et al.

Regarding claim 1, Wells meets the claimed limitations as follows:

"A method of controlling access to electronic information comprising the steps of:

providing at least one user apparatus;
a remote server;
and a communications link between the at least one user apparatus and the remote server;
allocating disk storage space on the remote server unique to the at least one user apparatus;
allowing at least one user access to the storage space via username and password login to the server and via secure encryption of data sent to or from the user apparatus from or to the server;" see paragraphs [0019] and [0030]-[0032]
and allowing at least one further user access to the data storage space and wherein the further users access to the data storage space can be managed by the at least one user with regard to times and dates when the at least one further user can write to and/or read from the data storage space." see paragraphs [0020], [0026] and Figures 3 and 8.

Regarding claim 8, Wells meets the claimed limitations as follows:

"A method of controlling access to electronic information as claimed claim 1, wherein the communications link comprises the Internet." see Abstract and paragraphs [0030], [0032].

Regarding claim 9, Wells meets the claimed limitations as follows:

"An electronic safety deposit system or tender box system comprising:

at least one user apparatus;
a remote server;

a communications link between the at least one user apparatus and the remote server;

disk storage space allocated on the remote server unique to the at least one user apparatus;

means for allowing at least one user access to the storage space via username and password login and via secure encryption of data sent to or from the user apparatus from or to the server; "see paragraphs [0019] and [0030]-[0032]

means for allowing at least one further user access to the data storage space; and means for managing the further users access to the data storage space by the at least one user with regard to times and dates when the at least one further user can write to and/or read from the data storage space." see paragraphs [0020], [0026] and Figures 3 and 8.

Regarding claim 10, Wells meets the claimed limitations as follows:

"A method of providing an account-based Internet/Intranet service which allows an at least one account holder to:

create at least one secure electronic deposit box on a centralised server in which-box or boxes store documentation in a secure environment;

manage timeframes for invited participants to access said documentation and/or for the invited participants to upload to the centralised server further documentation, wherein the method utilizes a method of controlling access to electronic information as claimed in claim 1." see paragraphs [0019]-[0020], [0025]-[0026], [0037]-[0038] and Figures 2, 3 and 8.

Regarding claim 11, Wells meets the claimed limitations as follows:

"A method as claimed in claim 10, wherein the method further allows the at least one account holder to track activity relating to each said at least one electronic deposit box." see paragraphs [0025] and [0041].

Regarding claim 13, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 1." see paragraph [0019].

Regarding claim 20, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 10." see paragraph [0019].

Regarding claim 21, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 11." see paragraph [0019].

Regarding claim 27, Wells meets the claimed limitations as follows:

"A method of controlling access to electronic information as claimed in claim 1, wherein managing of the at least one further users access to the data storage space by the at least one user involves the at least one user setting at least one date and at least one time period for access by the at least one further users." see paragraph [0037] and Figure 4.

Regarding claim 29, Wells meets the claimed limitations as follows:

"A programmed computer or server adapted to implement the method of claim 1." see paragraph [0019].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7, 12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent application 20040024714 granted to Wells et al and further in view of US patent 6,892,300 granted to Carroll et al.

Regarding claims 2, 3, 4, and 5, Wells discloses everything claimed as applied above (see claim 1), however Wells fails to teach users using digital certificates during secure transactions between the user and the electronic deposit box. Carroll teaches a secure method for conducting electronic commerce transactions with vault-based applications (safety deposit box) where users are required to present their digital certificates to gain access to the vault (see column 4, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll's secure electronic commerce with vault agents with Wells' electronic safe deposit box for the purpose of verifying specific users of the system. One of ordinary skill in the art would have been motivated to combine the two to gain the advantage of certifying the specific user conducting certain activities within the system (see Carroll; column 2, lines 26-33).

Regarding claim 7, Wells discloses everything claimed as applied above (see claim 1), however Wells fails to teach any users using digital certificates during secure

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transactions between the user and the electronic deposit box. Carroll teaches a secure method for conducting electronic commerce transactions with vault-based applications (safety deposit box) where users are required to present their digital certificates to gain access to the vault (see column 4, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll's secure electronic commerce with vault agents with Wells' electronic safe deposit box for the purpose of verifying specific users of the system. One of ordinary skill in the art would have been motivated to combine the two to gain the advantage of certifying the specific user conducting certain activities within the system (see Carroll; column 2, lines 26-33).

Regarding claims 12 and 18, Wells discloses everything claimed as applied above (see claim 9), however Wells fails to teach using digital certificates during secure transactions between the user and the electronic deposit box. Carroll teaches a secure method for conducting electronic commerce transactions with vault-based applications (safety deposit box) where users are required to present their digital certificates to gain access to the vault (see column 4, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll's secure electronic commerce with vault agents with Wells' electronic safe deposit box for the purpose of verifying specific users of the system. One of ordinary skill in the art would have been motivated to combine the two to gain the advantage of certifying the specific user conducting certain activities within the system (see Carroll; column 2, lines 26-33).

Regarding claim 17, Wells as modified discloses everything claimed as applied above (see claim 2), in addition Wells teaches encrypting transactions using SSL technology (see paragraphs [0029 and [0032]).

Allowable Subject Matter

Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 28, the cited prior art fails to specifically teach a method of controlling access to electronic information as claimed in claim 1, wherein access to the data storage space by the at least one user is inhibited when the access to the data storage space by the further users is allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Matthew B Smithers
Primary Examiner
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